

REMARKS

By this amendment, Claims 1, 7, 21, 30 and 33–35 are amended. Claims 4–6 have been canceled. No claims have been added. Hence, Claims 1–35 are pending in the application. The amendments to the claims as indicated herein do not add any new matter to this application. Furthermore, amendments made to the claims as indicated herein have been made to exclusively improve readability and clarity of the claims and not for the purpose of overcoming alleged prior art.

Each issue raised in the Office Action mailed May 30, 2007, is addressed hereinafter.

I. ISSUES RELATING TO CITED PRIOR ART

A. CLAIMS 1, 4–12, 16–35—WOLFF

Claims 1, 4–12, and 16–35 are rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 6,185,601, issued to *Wolff*, et al. (“*Wolff*”). The rejections are respectfully traversed.

Present Independent Claim 1 recites in part:

monitoring the server's performance, wherein monitoring comprises measuring one or more parameters selected from the group consisting of a currently available number of threads, a maximum number of available threads, memory usage percentage, and a number of processes running;

(Emphases added.) The Office action states that these elements, which were formerly a part of canceled Claims 4, 5 and 6, are inherently disclosed by the teachings of *Wolff*, and in particular because they are “important factors in terms of server performance.” (Office Action, paragraph 4.) Applicants respectfully disagree.

It is long-settled that inherency **may not be established by probabilities or possibilities**.

Hansgir v. Kemmer, 40 USPA 665, 667 (C.C.P.A. 1939). The mere fact that a certain thing

may result from a given set of circumstances is not sufficient. *Id.* (emphasis original). The descriptive matter that is missing from the reference must be **necessarily present** in the thing disclosed in the reference. *Finnigan Corp. v. ITC*, 51 USPQ2d 1001, 1009 (Fed. Cir. 1999). That the above-quoted elements are “important,” as stated in the Office action, is not sufficient to establish that the elements were inherently disclosed in *Wolff*. In other words, the elements recited in Claim 1 must be **necessarily** disclosed in *Wolff* as a **scientific fact**. *Application of Smythe*, 178 USPQ 279, 285 (C.C.P.A. 1973).

The Office action does not cite any particular section of *Wolff* as a basis of its finding of inherency. *Wolff* discloses a load-balance driver that performs utilization calculations based on total I/O sub-system usage over time. (Col. 11, lines 27–29.) *Wolff* also discloses node weights that correlate with the processing capability of the node. *Wolff* further discloses a utilization threshold, where utilization may refer to I/O utilization, processor utilization, or any combination thereof. However, “I/O utilization” or “processor utilization” do not **necessarily** include the parameters that Applicants claim. “Processor utilization” conventionally refers to the percentage of possible CPU processing cycles that are actually used for processing. This does not **necessarily require** tracking threads, memory usage percentage, or a number of processes running, as claimed.

To establish inherency between *Wolff* and Claim 1, it must be established that monitoring the performance of a server by measuring “a currently available number of threads, a maximum number of available threads, memory usage percentage, and a number of processes running,” as featured in Claim 1, are **necessarily present** in *Wolff*, or in the functions or features of *Wolff*, as a matter of **absolute certainty**. Anything less would be **merely a probability or a possibility** flowing from what is disclosed in *Wolff*, which is not sufficient to establish inherency. The

Office action does not establish such a certainty, and therefore, the Office action cannot rely on inherency with respect to Claim 1.

As one or more elements of Claim 1 are not expressly or inherently disclosed in *Wolff*, it is respectfully submitted that Claim 1 is patentable over *Wolff*, and is in condition for allowance.

Independent Claims 33–35 include features similar to Claims 1, except in the context of computer-readable media, in means-plus-function form, or as an apparatus claim. It is therefore respectfully submitted that Claims 33–35 are patentable over *Wolff* for at least the reasons given above with respect to Claims 1.

The rejections of Claim 4–6 are rendered moot by the amendments made to the claims herein.

Claim 7 was rejected on the basis that its features are inherently disclosed in *Wolff*, like Claims 4–6. Applicant respectfully submits that the features recited in Claim 7 are not inherent in *Wolff*. *Wolff's* description of monitoring “I/O utilization” and “processor utilization” does not necessarily require monitoring the availability of mandatory or dependent services, as claimed. *Wolff* also has no suggestion to monitor anything other than basic hardware parameters. The Office action does not establish a certainty that *Wolff* discloses the elements recited in Claim 7, and therefore, the Office action cannot rely on inherency with respect to Claim 7.

Claims 8–12 and 16–32 are dependent claims, each of which depends (directly or indirectly) on Claims 1. In addition, each of Claims 8–12 and 16–32 introduces one or more additional features that independently render it patentable. Due to the fundamental differences already identified, to expedite the positive resolution of this case, a separate discussion of the features of Claims 8–12 and 16–32 is not included at this time. The Applicant reserves the right

to further point out the differences between the cited art and the novel features recited in the dependent claims.

B. CLAIMS 2 AND 3—OFFICIAL NOTICE

Claims 2 and 3 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Wolff* in view taking Official Notice of certain elements not disclosed in *Wolff*. The rejections are respectfully traversed.

Taking Official Notice of facts without documentary evidence is not proper unless “specific factual findings predicated on sound technical and scientific reasoning” are provided to support the Official Notice. Assertions of technical facts must always be supported by citation of some reference work recognized as a standard in the pertinent art. *In re Ahlert*, 165 USPQ 418, 420–421; MPEP 2144.03. Any facts so noticed should be of notorious character and serve only to “fill in the gaps” in an insubstantial manner. It is **never appropriate to rely solely on common knowledge in the art** without evidentiary support in the record as **the principal evidence** upon which a rejection was based. (MPEP 2144.04 Section E.)

Regarding Claim 2, the Office action relies solely on Official Notice as principal evidence to teach that the server is an AAA server, and the one or more clients is an AAA client. This is not an appropriate use of Official Notice.

The Office action gives no specific factual finding other than that the invention would be beneficial as implemented on AAA servers and clients. This assertion of benefit is entirely unsupportive of the conclusion of common knowledge, because well-known and novel ideas and facts are both capable of providing benefit. Applicant respectfully requests that additional authority be produced for the statement that it is common-knowledge, or unquestionably well-

known, that the novel method disclosed in Claim 2 is actually **implemented with respect to AAA servers and clients.**

Regarding Claim 3, the Office action relies solely on Official Notice as principal evidence to teach that the message is an ICMP Echo message. This is not an appropriate use of Official Notice.

The Office action states that the ICMP Echo Message is among the older methods used to scan a network. However, the Office action does not provide any reasoning why it is “common knowledge,” or readily-verifiable, that the ICMP Echo Message would be the message sent in Claim 3. The use of the ICMP Echo Message, in combination with the monitoring, detecting, and sending steps, is entirely novel, even if the ICMP Echo Message is an older method. Thus, the use of a ICMP Echo Message, **in this specific use**, is not common knowledge. The ICMP Echo Message cannot be viewed in a vacuum, without context. Applicant respectfully requests that additional authority be produced for the statement that it is common knowledge, and unquestionably well-known, that this message is used in the novel combination of the monitoring, detecting, and sending steps as recited in Claim 3.

B. CLAIMS 13–15—WOLFF in view of LINDEMAN

Claims 13–15 are dependent claims, each of which depends (directly or indirectly) on Claims 1. The Office action relies on *Lindeman* for teaching the limitations within those dependent claims. However, *Lindeman* does not “fill the gaps” that *Wolff* leaves with respect to independent Claim 1. Any combination of *Wolff* and *Lindeman* fails to provide the complete claimed subject matter of Claim 1. Due to the fundamental differences already identified, to expedite the positive resolution of this case, a separate discussion of the features of Claims 13–15 is not included at this time. In addition, each of Claims 13–15 introduces one or more

additional features that independently render it patentable. The Applicant reserves the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

In view of the foregoing, it is respectfully asserted that the claims are now in condition for allowance.

CONCLUSION

For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

A petition for extension of time for one (1) month, and otherwise for the time necessary to make this reply timely filed, is hereby made under 37 C.F.R. 1.136. The extension of time fee is submitted concurrently herewith. Please charge any shortages or credit any overages to Deposit Account No. 50-1302.

Respectfully submitted,
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